PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Masayuki NATE et al. Group Art Unit: 3749

Application No.: 10/506,968 Examiner: J. LU

Filed: September 8, 2004 Docket No.: 121042

For: METHOD OF DRYING HONEYCOMB FORMED BODY

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

A Notice of Appeal is attached. Applicants respectfully request review of the Final Rejection mailed May 31, 2007 regarding the above-identified application in light of the following remarks. Claims 14, 15, 18, 22, 24, 26, 28, 30, 32 and 33 are pending in this application. Claims 14, 15, 18, 22, 24, 26, 28, 30, 32 and 33 are rejected. This review is requested for the following reasons.

I. Specific Features Recited in the Pending Claims are Neither Taught, nor Would They Have Been Suggested, by the Applied References

The Office Action, in paragraph 5, rejects claims 14, 32 and 33 under 35 U.S.C. §102(b) as being anticipated by JP-A-2001-019560 to Takamitsu et al. (hereinafter "Takamitsu '560"). The Office Action, in paragraph 6, rejects claims 14, 32 and 33 under 35 U.S.C. §102(e) as being anticipated by JP-A-2002-020173 to Takamitsu et al. (hereinafter "Takamitsu '173"). The Office Action, in paragraph 7, rejects claims 14, 18, 32 and 33 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,725,567 to Yano et al.

(hereinafter "Yano"). The Office Action, in paragraph 8, rejects claims 14, 18 and 20 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,388,345 to Brundage et al. (hereinafter "Brundage"). The Office Action, in paragraph 9, rejects claims 14, 18, 32 and 33 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,539,633 to Araya. The Office Action, in paragraph 11, rejects claim 15 under 35 U.S.C. §103(a) as being unpatentable over Takamitsu '560 or Takamitsu '173 or Yano or Brundage or Araya. The Office Action, in paragraph 12, rejects claims 22, 24, 26, 28 and 30 under 35 U.S.C. §103(a) as being unpatentable over Takamitsu '560 or Takamitsu '173 or Yano or Brundage or Araya in view of U.S. Patent No. 6,932,932 to Miura et al. (hereinafter "Miura") or JP-A-2001-130973 to Kazuya. These rejections are respectfully traversed.

The Office Action, in paragraphs 4-9, asserts that the each of Takamitsu '560, Takamitsu '173, Yano, Brundage and Araya teach structures with features that are alleged to correspond to the combinations of all of the features recited in independent claim 14. The analysis of the Office Action fails for at least the following reasons.

None of Takamitsu '560, Takamitsu '173, Yano, Brundage nor Araya, individually or in combination, teach the extent that any alleged guide covers any alleged outer wall as being in the range of 20 to 100% relative to the surface area of the entire outer wall, as positively recited in claim 14.

The Office Action, in paragraphs 4-9, asserts that the above-quoted feature is disclosed in each of Fig. 1 of Takamitsu '560, Fig. 4 of Takamitsu '173, Fig. 1 of Yano, Figs. 1a, 1b, 4a and 4b of Brundage and Figs. 1 and 2 of Araya. However, none of the figures cited by the Office Action teaches that any alleged guide is in the claimed range relative to the surface of the outer wall.

MPEP §2125 states "[w]hen the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features

are of little value." *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000). The MPEP section also notes that it is "well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue" (emphasis added). The above-quoted feature recites a specific dimensional relationship of the guide covering the outer wall, which is not disclosed by any reasonable interpretation of the figures in the applied references. As such, it is unreasonable to assert that any of the applied references anticipates at least this feature.

To the extent that the Office Action asserts that any alleged "covering" of a structure by the applied references can somehow be considered to overlap the specific range of 20 to 100%, recited in claim 14, the Office Action fails to establish anticipation by ranges. MPEP § 2131.03(II) states "[w]hen the prior art discloses a range which touches or overlaps the claimed range, but no specific examples falling within the claimed range are disclosed, a case-by-case determination must be made as to anticipation." The MPEP section goes on to indicate that the claimed subject matter must be disclosed in the reference with "sufficient specificity to constitute an anticipation under the statute." In cases where the claims are directed to a narrow range and the reference teaches a broad range, depending on the other facts of the case, we are instructed that it may be reasonable to conclude that the narrow range is not disclosed with "sufficient specificity" to constitute an anticipation of the claims. See, e.g., *Atofina v. Great Lakes Chem. Corp*, 441 F.3d 991, 999, 78 USPQ2d 1417, 1423 (Fed. Cir. 2006). As discussed above, the Office Action relies solely on non-scaled depictions in drawings in asserting that a range is even disclosed by any of the applied references. Applicants recite the specific range of 20 to 100%.

As such, the applied references fail to disclose a corresponding range, examples within the claimed range, or the claimed range with sufficient specificity.

Neither Miura or Kazuya are applied in a manner to overcome the above-identified shortfalls in the application of each of Takamitsu '560, Takamitsu '173, Yano, Brundage and Araya to the subject matter of claim 14.

II. Conclusion

In summary, the applied references do not teach, nor can they reasonably be considered to have suggested, the combinations of all of the features positively recited in at least independent claim 14. Further, claims 15, 18, 22, 24, 26, 28, 30, 32 and 33 are also neither taught, nor would they have been suggested, by the applied references for at least the respective dependence of these claims, directly or indirectly, on an allowable base claim, as well as for the separately patentable subject matter that each of these claims recites.

In view of the foregoing, Applicants respectfully request that the Review Panel review the substance of the May 31, 2007 Final Rejection in light of the above remarks. Applicants believe that upon such review, the Review Panel will determine that the applied references do not anticipate, nor would they have rendered obvious, the subject matter of the pending claims. In this regard, favorable reconsideration and prompt allowance of claims 14, 15, 18, 22, 24, 26, 28, 30, 32 and 33, are earnestly solicited.

Should the Review Panel believe that anything further would be desirable in order to place this application in an even better condition for allowance, the Review Panel is invited to contact Applicants' undersigned representative.

Respectfully submitted,

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JAO:CJW/clf

Attachment:
Notice of Appeal and Petition for Extension of Time

Date: October 31, 2007

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